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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/553,209

10/13/2005

Takaaki Miyoshi

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STAAS & HALSEY LLP
SUITE 700
1201 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

EXAMINER

WOODWARD, ANA LUCRECIA

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/553,209	Applicant(s) MIYOSHI ET AL.	
	Examiner Ana L. Woodward	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 February 2006; 13 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>2/3/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102/103

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 16 and 17 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over U.S. 5,124,391 (Muehlbach et al).

Muehlbach et al disclose resin composition comprising

- A) polyamide,
- B) polyphenylene ether,
- C) a fibrous or particulate filler or mixture thereof,
- D) zinc sulfide pigment
- E) impact-modifying rubber and
- F) flameproofing agent.

In claim 4, the use of a mixture of carbon fibers and wollastonite, corresponding respectively to applicants' (D) and (E) components, as the reference's component C) are immediately envisaged to one having ordinary skill in the art given the small genus disclosed

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(column 6, lines 7-10). Regarding, applicants' component (C), the use of such as the reference's component E) is immediately envisaged to one having ordinary skill in the art given its' preferred use in the examples.

The disclosure of the reference meets the requirements of the present claims in terms of the types of materials added. The onus is shifted to applicants to establish that the product of the present claims is not the same as or obvious from that set forth by the reference.

Regarding product-by-process claim 17, while the claim may recite process limitations, it is the patentability of the product which must be established.

Claim Rejections - 35 USC § 103

4. Claims 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. 5,124,391 (Muehlbach et al) described hereinabove further in view of U.S. 5,965,655 (Mordecai et al).

Assuming arguendo, that the disclosure of the reference does not anticipate the presently claimed subject matter, it is maintained that it would have been obvious to one having ordinary skill in the art to have formulated a composition as presently claimed as per such being within the purview of the general disclosure of the reference.

Regarding claims 18 and 19, it would be obvious to one having ordinary skill in the art to have employed wollastonite filler having any conventional diameter and aspect ratio (inclusive of that presently claimed) with the reasonable expectation of success. In this regard, attention is directed to Mordecai et al teachings regarding the expected advantages, e.g., improved surface characteristics, other improved properties, of employing wollastonite having dimensions as

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presently claimed. Accordingly, absent evidence of unusual or unexpected results, no patentability can be seen in the presently claimed subject matter.

5. Claims 1-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. 7,220,795 (Miyoshi et al) further in view of U.S. 5,965,655 (Mordecai et al).

Miyoshi et al disclose conductive resin compositions comprising a polyamide, a polyphenylene ether, an impact modifier and a carbon type filler, the filler residing in a phase of the polyphenylene ether. From the figures, it is evident that the polyphenylene ether phase resides in a continuous phase of the polyamide. The polyamide in the invention may be a mixture of at least two polyamides having different molecular weights and different concentrations of terminal (amino) groups (column 4, lines 20-63). Exemplary polyamides include nylon 6 and nylon 66. The preferred amino group concentration is at least 10 milliequivalents/kg. As to the polyphenylene ether, a blend of at least two sorts of polyphenylene ethers having different molecular weights, as per instant claims 7 and 8, is disclosed but not exemplified (column 5, lines 53-62). The block copolymer comprises an aromatic vinyl compound and a conjugated diene compound, in a weight ratio of 10/90 and 90/10 and preferably has a number molecular weight from 10,000 to 500,000 (column 8, line 65 -column 9). Further, a blend of at least two sorts of block copolymers having different weight ratios of aromatic vinyl compound to conjugated diene compound, as per instant claim 10, may be employed. The carbon type filler of the reference meets the requirements of applicants' claim 10 (column 11, lines 1-66, etc.). Conventional adjuvants, inclusive of wollastonite, may be further incorporated into the reference composition (column 16, line 43).

The reference differs in essence from present claim 1 in disclosing but not expressly exemplifying a composition containing at least two different polyamide components. It is maintained that it would have been obvious to one having ordinary skill in the art to have employed a mixture of at least two polyamides for their expected additive effect, particularly since patentees clearly disclose said embodiment. The additional embodiments dependent from claim 1 are similarly deemed to be obvious variants of the reference disclosure to one having ordinary skill in the art. Accordingly, absent evidence of unusual or unexpected results, no patentability can be seen in the presently claimed subject matter.

The reference differs in essence from present claim 16 in disclosing but not expressly exemplifying a composition containing wollastonite. It would have been obvious to one having ordinary skill in the art to have employed wollastonite filler having any conventional diameter and aspect ratio (inclusive of that presently claimed) with the reasonable expectation of success. In this regard, attention is directed to Miyoshi et al's disclosure of adding wollastonite and to Mordecai et al teachings regarding the expected advantages, e.g., improved surface characteristics, other improved properties, of employing wollastonite having dimensions as presently claimed. Accordingly, absent evidence of unusual or unexpected results, no patentability can be seen in the presently claimed subject matter.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ana L. Woodward whose telephone number is (571) 272-1082. The examiner can normally be reached on Monday-Friday (8:30-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James J. Seidleck can be reached on (571) 272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ana L. Woodward/
Primary Examiner
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